REMARKS

Claims 1-51 were pending in this application.

Claims 1-38 have been rejected.

Claims 39-51 have been allowed.

No claims have been amended.

Claims 1-51 remain pending in this application.

Reconsideration and full allowance of Claims 1-51 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 39-51 are allowable. These claims have not been amended and therefore remain in condition for allowance.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-7, 9-16, 18-24, and 26-37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,740,163 to Herve ("*Herve*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP § 2131; In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)*). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP § 2131; In re Donohue, 766 F.2d 531,*

534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Herve recites a "dual-mode ISDN/STN videophone terminal" capable of being connected to an integrated services digital network (ISDN) or a switched telephone network (STN). (*Abstract; Col. 1, Lines 25-27*). The terminal includes ISDN audio and video encoders and decoders, along with STN audio and video encoders and decoders. (*Abstract*). A switch (element 28) is used to select either ISDN or STN mode. (*Col. 3, Lines 58-65*).

Herve simply recites that a terminal may be configured to use one or more encoders and one or more decoders depending on the type of network. *Herve* lacks any mention of determining how to encode data using an encoder based on data received by a decoder. For example, *Herve* lacks any mention of using the STN encoders when the STN decoders have received STN-encoded data. Similarly, *Herve* lacks any mention of using the ISDN encoders when the ISDN decoders have received ISDN-encoded data. In particular, *Herve* lacks any mention of setting the switch (element 28) based on the data received by one or more of the decoders. Based on this, *Herve* fails to anticipate sensing the mode in which incoming information was encoded and then using this mode to both decode the incoming information and to encode outgoing information.

As a result, *Herve* fails to anticipate a "decoder portion" in a controller that is operable to direct a "decoder" to decode received data in a particular mode and to direct an "encoder portion" of the controller to direct an "encoder" to encode data in the particular mode "in response to sensing data received" in the particular mode "at said decoder" as recited in Claims 1 and 18. Similarly, *Herve* fails to anticipate "sensing data received at [a] decoder in" one of

multiple modes and directing an encoder, "in response to sensing data received" in one of the modes, to encode data in that mode as recited in Claim 9. In addition, *Herve* fails to anticipate "sensing data received at a decoder" in one of multiple modes and encoding data in that mode "in response to sensing data received at said decoder" as recited in Claim 26.

Moreover, *Herve* lacks any mention of a controller that includes both encoder and decoder portions, where the decoder portion is capable of causing the encoder portion to perform an action. Specifically, *Herve* fails to anticipate a controller that includes both an "encoder portion" and a "decoder portion," where the "decoder portion" is capable of causing the "encoder portion" to direct an "encoder" to encode data in a particular mode as recited in Claims 1, 9, and 18.

For these reasons, *Herve* does not anticipate the Applicants' invention as recited in Claims 1, 9, 18, and 26 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1-7, 9-16, 18-24, and 26-37.

III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 8, 17, 25, and 38 under 35 U.S.C. § 103(a) as being unpatentable over *Herve* in view of U.S. Patent No. 6,721,916 to Agazzi ("*Agazzi*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260,*

1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

As described above in Section II, Claims 1, 9, 18, and 26 are patentable. As a result, Claims 8, 17, 25, and 38 are patentable due to their dependence from allowable base claims.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 8, 17, 25, and 38.

IV. CONCLUSION

As a result of the foregoing, the Applicants assert that the claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at ***wmunck@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@davismunck.com*